

Docket No. 196944US-6X PCT
ENKEL 8292

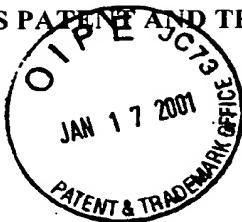
ip3300

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: MATS LEIJON ET AL
SERIAL NO: 09/509,428
FILED: JUNE 9, 2000
FOR: AN ELECTRIC POWER PLANT

GAU: 3700
EXAMINER: UNASSIGNED

2834



INFORMATION DISCLOSURE/RELATED CASE STATEMENT UNDER 37 CFR 1.97

**ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231**

SIR:
Applicant(s) wish to disclose the following information.

[Handwritten signature]

REFERENCES

- The Applicant(s) wish to make of record the references listed on the attached form PTO-1449 which are relevant to the present case as well as related "bulk filing applications" cases, as discussed in Paper No. 11 (copy enclosed) Response to Petition under 37 CFR 1.182 Seeking Special Treatment Relating to an Electronic Search Tool, and Decision on Petition under 37 CFR 1.183 Seeking Waiver of Requirements under 37 CFR 1.98 (i.e., the "Response to Petition"). Because the references were cited by foreign examiners in a foreign case that corresponds with one of the U.S. "bulk filing applications", or were uncovered by the present assignee in the course of performing supplemental searches the references are believed to be relevant to the present application and bulk filing applications. Three copies of each of the listed references were provided in "holding application" Serial No. 09/147,325 filed February 17, 1999 to the Patent Office consistent with the requirements in the Response to Petition.
- A check is attached in the amount required under 37 CFR §1.17(p).

RELATED CASES

- Attached is a list of applicant's pending application(s) or issued patent(s) which may be related to the present application. A copy of the patent(s), together with a copy of the claims and drawings of the pending application(s) is attached along with PTO 1449.
- A check is attached in the amount required under 37 CFR §1.17(p).

CERTIFICATION

- Each item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.
- No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this statement.

DEPOSIT ACCOUNT

- Please charge any additional fees for the papers being filed herewith and for which no check is enclosed herewith, or credit any overpayment to deposit account number 15-0030. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



22850

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INFORMATION DISCLOSURE CITATION LIST ALTERNATE FORM PTO-1449 (Corrected Listing of Original List)		Docket Number: 196944US6XPCT	Application Number 09/509,428
		Applicant(s): Mats Leijon et al	JAN 17 2001 O I P E S C 13 U. S. PATENT AND TRADEMARK OFFICE
		Filing Date: June 9, 2001	Group Art Unit: 3700

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
1		US1304451	5/20/19	L. H. Burnham			
2		US1418856	6/2/22	Robert B. Williamson			
3		US1481585	1/22/24	James Robert Beard			
4		US1728915	9/24/29	E. P. Blankenship et al			
5		US1742985	1/7/30	L. H. Burnham			
6		US1747507	2/18/30	Robert B. George			
7		US1756672	4/29/30	John M. Barr			
8		US1762775	6/10/30	Albert G. Ganz			
9		US1781308	11/11/30	Mauritz Vos			
10		US1861182	5/31/32	F. Hendey et al			
11		US1974406	9/25/34	Vincent G. Apple et al			
12		US2006170	6/25/35	Gustof A. Juhlin			
13		US2206856	7/2/40	W. E. Shearer			
14		US2217430	10/8/40	R. A. Baudry			
15		US2241832	5/13/41	H.W. Wahlquist			
16		US2251291	8/5/41	L. O. Reichelt			
17		US2256897	9/23/41	W. F. Davidson et al			
18		US2295415	9/8/42	G.R. Monroe			
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24		US2462651	2/22/49	H. W. Lord			
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36		US3130335	4/21/64	L. J. Rejda			
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Examiner

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*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

INFORMATION DISCLOSURE CITATION LIST
ALTERNATE FORM PTO-1449
(Corrected Listing of Original List)



	45	US3418530	11/24/68	W. H. Cheever	
	46	US3435262	3/25/69	R. B. Bennett et al	
	47	US3437858	4/8/69	R. B. White	
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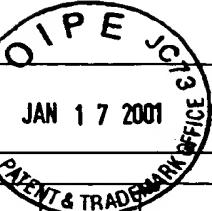
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	169	US4551780	11/5/85	M. Canay		
	170	US4557038	12/10/85	M. Wcislo et al		
	171	US4560896	12/24/85	G. Vogt et al		
	172	US4565929	1/21/86	J. Baskin et al		
	173	US4588916	5/13/86	R. Lis		
	174	US4590416	5/20/86	M. Porche et al		
	175	US4594630	6/10/86	M. Rabinowitz et al		
	176	US4607183	8/19/86	J. Rieber et al		
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	179	US4619040	10/28/86	D. Wang et al		
	180	US4633109	12/30/86	J. Feigel		
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	197	US4860430	8/29/89	H. Raschbichler et al		
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JAN 17 2001



	199	US4883230	11/28/89	L. Lindstrom		
	200	US4894284	1/16/90	S. Yamanouchi et al		
	201	US4914386	4/3/90	S. Zocholl		
	202	US4918347	4/17/90	Y. Takaba		
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	241	US5397513	3/14/95	C. Steketee, Jr.		
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(Corrected Listing of Original List)



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Subtotal	259				

FOREIGN PATENT DOCUMENTS

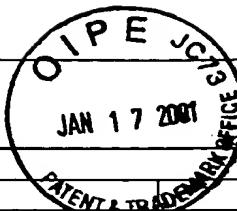
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3		CH391071	4/30/65	Switzerland		
4		CH534448	2/28/73	Switzerland		
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7		DD137164	8/15/79	Germany DDR		
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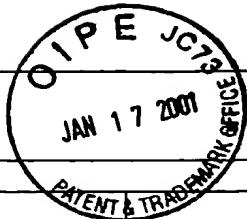
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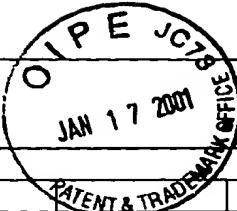
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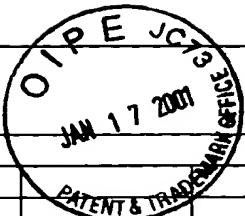
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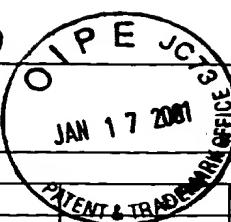
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ALTERNATE FORM PTO-1449

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ALTERNATE FORM PTO-1449
(Corrected Listing of Original List)

JAN 17 2001



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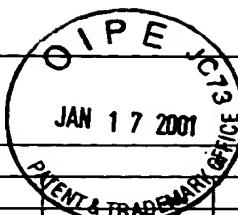
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ALTERNATE FORM PTO-1449
(Corrected Listing of Original List)

JAN 17 2001



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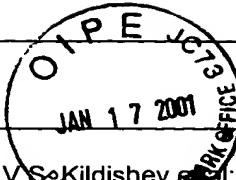
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	24	OD024	Underground Transmission Systems Reference Book; 1992; pp16-19; pp36-45; pp67-81
	25	OD025	Power System Stability and Control; P. Kundur, 1994; pp23-25; page 767
	26	OD026	Six phase Synchronous Machine with AC and DC Stator Connections, Part II: Harmonic Studies and a proposed Uninterruptible Power Supply Scheme; R. Schiferl et al.; 8/1983 pp 2694-2701
	27	OD027	Six phase Synchronous Machine with AC and DC Stator Connections, Part 1: Equivalent circuit representation and Steady-State Analysis; R. Schiferl et al; 8/1983; pp2685-2693
	28	OD028	Reactive Power Compensation; T. Petersson; 1993; pp 1-23
	29	OD030	Permanent Magnet Machines; K. Binns; 1987; pp 9-1 through 9-26
	30	OD031	Hochspannungsanlagen für Wechselstrom; 97. Hochspannungsaufgaben an Generatoren und Motoren; Roth et al; 1938; pp452-455
	31	OD032	Hochspannungsanlagen für Wechselstrom; 97. Hochspannungsaufgaben an Generatoren und Motoren; Roth et al; Spring 1959, pp30-33
	32	OD033	Neue Lösungswege zum Entwurf grosser Turbogeneratoren bis 2GVA, 60kV; G. Aichholzer; 9/1974, pp249-255
	33	OD034	Advanced Turbine-generators- an assessment; A. Appleton, et al; International Conf. Proceedings, Lg HV Elec. Sys. Paris, FR, Aug-Sept/1976, Vol I, Section 11-02, pg1-9
	34	OD035	Fully slotless turbogenerators; E. Spooner; Proc., IEEE Vol 120 #12, 12/1973
	35	OD036	Toroidal winding geometry for high voltage superconducting alternators; J. Kirtley et al; MIT - Elec. Power Sys. Engrg. Lab for IEEE PES; 2/1974
	36	OD037	High-Voltage Stator Winding Development; D. Albright et al; Proj. Report EL339, Project 1716, April 1984
	37	OD038	POWERFORMER™: A giant step in power plant engineering; Owman et al; CIGRE 1998, Paper 11:1.1
	38	OD039	Thin Type DC/DC Converter using a coreless wire transformer; K. Onda et al; Proc. IEEE Power Electronics Spec. Conf.; 6/1994, pp330-334
	39	OD040	Development of extruded polymer insulated superconducting cable; 1/1992
	40	OD041	Transformer core losses; B. Richardson; Proc. IEEE 5/1986, pp365-368
	41	OD042	Cloth-transformer with divided windings and tension annealed amorphous wire; T. Yamamoto et al; IEEE Translation Journal on Magnetics in Japan Vol 4, No. 9 Sept. 1989
	42	OD043	A study of equipment sizes and constraints for a unified power flow controller; J Bian et al; IEEE 1996
Subtotal	43		

GRAND TOTAL	671		
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Examiner	Date Considered
*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

INFORMATION DISCLOSURE CITATION LIST ALTERNATE FORM PTO-1449		Docket Number: 196944US6XPCT	Application Number 09/509,428
Issue 2: dated 02/21/00		Applicant(s): Mats Leijon et al	JAN 17 2001 PATENT & TRADEMARK OFFICE O C G
		Filing Date: June 9, 2000	
Group Art Unit: 3700			

U.S. PATENT DOCUMENTS

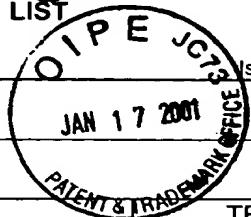
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1		US 4,292,558	9/29/1981	Carl Flick et al			
2		US 4,656,316	4/7/1987	Hans-Juergen Meltsch			
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**INFORMATION DISCLOSURE CITATION LIST
ALTERNATE FORM PTO-1449**

Issue2: dated 02/21/00



FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
				YES	NO
1	GB 1,319,257	6/6/1973	Anders R. Andersson et al		
2	GB 1,322,433	7/4/1973	Siemens Akstiengesellschaft		
3	GB 2,070,341	9/3/1981	Hans-Georg Raschbichler et al		
4	WO 98/20598	5/14/1998	Jan-Anders Karlfeldtsgatan et al		
5	WO 98/20602	5/14/1998	Soren Berggren		
6	WO 98/34239	8/6/1998	Gunnar Steneorpsgatan et al		
7	WO 99/28922	6/10/1999	Thorsten Schutte et al		
8	WO 99/29005	6/10/1999	Mats Leijon et al		
9	WO 99/29023	6/10/1999	Peter Carstensen et al		
10	WO 99/29025	6/10/1999	Mats Leijon et al		
11	EP 0056580 A1	7/28/1982	Jacobus F.H. Van der Vegt		
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INFORMATION DISCLOSURE CITATION LIST
ALTERNATE FORM PTO-1449

JAN 17 2001



Issue2: dated 02/21/00

OTHER REFERENCES (Including Title, Author, Date, Pertinent Pages, etc.)

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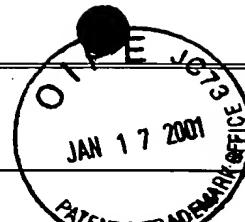
Docket Number:
196944US6XPCT

Application Number
09/509,428

Applicant(s):
Mats Leijon et al

Filing Date:
June 9, 2000

Group Art Unit:
3700



U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	1	US 1,508,456	9/16/24	W.G.Lenz			
	2	US 1,904,885	4/18/33	G.A.Seeley			
	3	US 2,409,893	10/22/46	W.W. Pendleton et al			
	4	US 2,650,350	8/25/53	P.D. Heath			
	5	US 2,749,456	06/05/56	F.O. Luenberger			
	6	US 3, 014, 139	12/19/61	L.P. Shildneck			
	7	US 3,197,723	7/27/65	I.K.Dortort			
	8	US 3,392,779	7/16/68	K.B. Tilbrook			
	9	US 3,411,027	11/12/68	H. Rosenberg			
	10	US 3,541,221	11/17/70	M.Aupoix et al			
	11	US 3,571,690	3/23/71	V V A V Lataisa			
	12	US 3,651,244	3/21/72	D.A. Silver et al			
	13	US 3,660,721	5/2/72	L.L.Baird			
	14	US 3,666,876	5/30/72	E.O.Forster			
	15	US 3,684,906	8/15/72	H.G.Lexz			
	16	US 3,699,238	10/17/72	T.E.Hansen et al			
	17	US 3,743,867	7/3/73	J.L. Smith, Jr.			
	18	US 3,787,607	1/22/74	H.J.Schlaflly			
	19	US 3,813,764	6/4/74	E. Tanaka et al			
	20	US 3,828,115	8/6/74	A.Hvizd, Jr.			
	21	US 3,912,957	10/14/75	H.B. Reynolds			
	22	US 3,993,860	11/23/76	J.P.Snow et al			
	23	US 4,008,367	2/15/77	H. Sunderhauf			
	24	US 4,132,914	1/2/79	G.M. Khutoretsky			
	25	US 4,314,168	2/2/82	O. Breitenbach			
	26	US 4,321,426	3/23/82	F.K.Schaeffer			
	27	US 4,361,723	11/30/82	A.Hvizd Jr. et al			
	28	US 4,365,178	12/21/82	H.G.Lexz			
	29	US 4,367,890	1/11/83	F.Spirk			
	30	US 4,384,944	5/24/83	D. A. Silver et al			
	31	US 4,401,920	8/30/83	R.S.Taylor et al			
	32	US 4,432,029	2/14/84	B. Lundqvist			
	33	US 4,437,464	3/20/84	J.J.Crow			
	34	US 4,484,106	11/20/84	R.S.Taylor et al			
	35	US 4,490,651	12/25/84	R.S.Taylor et al			
	36	US 4,508,251	4/2/85	K.Harada et al			
	37	US 4,520,287	5/28/85	D.C.Wang et al			
	38	US 4,571,453	2/18/86	M.Takaoka et al			
	39	US 4,615,778	10/7/86	R.K.Elton			
	40	US 4,622,116	11/11/86	R.K.Elton et al			
	41	US 4,652,963	3/24/87	N. Fahlen			
	42	US 4,723,083	2/2/88	R.K.Elton			
	43	US 4,724,345	2/9/88	R.K.Elton et al			
	44	US 4,732,412	3/22/88	R. D.A. van der Linden et al			

Examiner

Date
Considered

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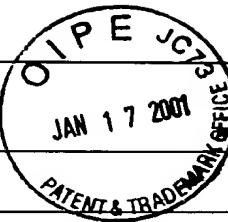
INFORMATION DISCLOSURE CITATION LIST
ALTERNATE FORM PTO-1449
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Subtotal **65170**

Examiner _____ **Date** _____
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INFORMATION DISCLOSURE CITATION LIST
ALTERNATE FORM PTO-1449



FOREIGN PATENT DOCUMENTS				
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				YES NO
1	DE 209,313	4/25/84	Germany	
2	DE 134,022	12/28/01	Germany	
3	DE 1,465,719	5/22/69	Germany	
4	DE 19,020,222	3/13/97	Germany	
5	DE 19,620,906	1/8/96	Germany	
6	DE 386,561	12/13/23	Germany	
7	DE 3,925,337	2/7/91	Germany	
8	DE 406,371	11/21/24	Germany	
9	DE 4,402,184	8/3/95	Germany	
10	DE 4,438,186	5/2/96	Germany	
11	DE 975,999	1/10/63	Germany	
12	EP 0,102,513	1/22/86	European	
13	EP 0,185,788	7/2/86	European	
14	EP 0,221,404	5/16/90	European	
15	EP 0,503,817	9/16/92	European	
16	EP 0,620,630	10/19/94	European	
17	EP 0,739,087 A2	10/23/96	European	
18	EP 0,739,087 A3	3/27/97	European	
19	EP 0,749,193 A3	3/26/97	European	
20	EP 0,749,190 A2	12/18/96	European	
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22	FR 2,481,531	10/30/81	France	
23	FR 916,959	12/20/46	France	
24	EP 0,221,404	5/16/90	European	
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26	EP 0,469,155 A1	2/5/92	European	
27	GB 2,150,153	6/26/85	United Kingdom	
28	GB 2,332,557	6/23/99	United Kingdom	
29	DE 468,827	7/13/97	Germany	
30	GB 666,883	2/20/52	United Kingdom	
31	GB 739,962	11/2/55	United Kingdom	
32	HU 175,494	11/28/81	Hungary	
33	JP 2,017,474	1/22/90	Japan	
34	JP 57,126,117	5/8/82	Japan	
35	JP 62,320,631	6/23/89	Japan	
36	JP 7,161,270	6/23/95	Japan	
37	JP 8,036,952	2/6/96	Japan	
38	JP 8,167,360	6/25/96	Japan	
39	SU 1,189,322	10-86	Switzerland	
40	SU 266,037	10/11/65	Switzerland	
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42	WO 91/11841	8/8/91	PCT	
43	PCT SE 91/00077	4/23/91	Int'l Search Report	
44	WO 91/15755	10/17/91	PCT	
45	WO 97/29494	8/14/97	PCT	
46	WO 98/40627	9/17/98	PCT	
47	WO 98/43336	10/1/98	PCT	
48	PCT/DE 90/00279	11/27/90	Int'l Search Report	

Examiner

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JAN 17 2001

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INFORMATION DISCLOSURE CITATION LIST
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OTHER REFERENCES (Including Title, Author, Date, Pertinent Pages, etc.)

	1	OD 044	A test installation of a self-tuned ac filter in the Konti-Skan 2 HVDC link; T. Holmgren, G. Asplund, S. Valdemarsson, P. Hidman of ABB; U. Jonsson of Svenska Kraftnat; O. loof of Vattenfall Vastsverige AB; IEEE Stockholm Power Tech Conference 6/1995, pp 64-70
	2	OD 045	Analysis of faulted Power Systems; P Anderson, Iowa State University Press / Ames, Iowa, 1973, pp 255-257
	3	OD 046	36-Kv. Generators Arise from Insulation Research; P. Sidler; <i>Electrical World</i> 10/15/1932, ppp 524
	4	OD 047	Oil Water cooled 300 MW turbine generator; L.P. Gnedin et al; <i>Elektrotechnika</i> , 1970, pp 6-8
	5	OD 048	J&P Transformer Book 11 th Edition; A. C. Franklin et al; owned by Butterworth – Heinemann Ltd, Oxford Printed by Hartnolls Ltd in Great Britain 1983, pp29-67
	6	OD 049	Transformerboard; H.P. Moser et al; 1979, pp 1-19
	7	OD 050	The Skagerrak transmission – the world's longest HVDC submarine cable link; L. Haglof et al of ASEA; ASEA Journal Vol 53, Number 1-2, 1980, pp 3-12
	8	OD 051	Direct Connection of Generators to HVDC Converters: Main Characteristics and Comparative Advantages; J. Arrillaga et al; <i>Electra</i> No. 149, 08/ 1993, pp 19-37
	9	OD 052	Our flexible friend article; M. Judge; <i>New Scientist</i> , 05/10/1997, pp 44-48
	10	OD 053	In-Service Performance of HVDC Converter transformers and oil-cooled smoothing reactors; G.L. Desilets et al; <i>Electra</i> No. 155, 08/1994, pp 7-29
	11	OD 054	Transformateurs a courant continu haute tension-examen des specifications; A. Lindroth et al; <i>Electra</i> No 141, 04/1992, pp 34-39
	12	OD 055	Development of a Termination for the 77 KV-Class High Tc Superconducting Power Cable; T. Shimonosono et al; IEEE Power Delivery, Vol 12, No 1, 01/1997, pp 33-38
	13	OD 056	Verification of Limiter Performance in Modern Excitation Control Systems; G. K. Gergis et al; IEEE Energy Conservation, Vol. 10, No. 3, 09/1995, pp 538-542
	14	OD 057	A High Initial response Brushless Excitation System; T. L. Dillman et al; IEEE Power Generation Winter Meeting Proceedings, 01/31/1971, pp 2089-2094
	15	OD 058	Design, manufacturing and cold test of a superconducting coil and its cryostat for SMES applications; A. Bautista et al; IEEE Applied Superconductivity, Vol 7, No. 2, 06/1997, pp 853-856
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	17	OD 060	Design and Construction of the 4 Tesla Background Coil for the Navy SMES Cable Test Apparatus; D.W.Scherbarth et al; IEEE Applie Superconductivity, Vol. 7, No. 2, 06/1997, pp 840-843
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	19	OD 062	Billig burk motar overtonen; A. Felldin; <i>ERA (TEKNIK)</i> 08/1994, pp 26-28
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	23	OD 066	Fully Water-Cooled 190 MVA Generators in the Tonstad Hydroelectric Power Station; E. Ostby et al; BBC Review 08/1969, pp 380-385
	24	OD 068	Relocatable static var compensators help control unbundled power flows; R. C. Knight et al; <i>Transmission & Distribution</i> , 12/1996, pp 49-54
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	26	OD 070	Variable-speed switched reluctance motors; P.J. Lawrenson et al; IEE proc, Vol 127, Pt.B, No.4, 07/1980, pp 253-265

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INFORMATION DISCLOSURE CITATION LIST
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	27	OD 071	Das Einphasenwechselstromsystem hoherer Frequenz; J.G. Heim; Elektrische Bahnen eb; 12/1987, pp 388-389
	28	OD 072	Power Transmission by Direct Current; E. Uhlmann; ISBN 3-540-07122-9 Springer-Verlag, Berlin/Heidelberg/New York; 1975, pp 327-328
	29	OD 073	Elektriska Maskiner; F. Gustavson; Institute for Elkraefteknik, KTH; Stockholm, 1996, pp 3-6 - 3-12
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	31	OD 075	Insulation systems for superconducting transmission cables; O. Toennesen; Nordic Insulation Symposium, Bergen, 1996, pp 425-432
	32	OD 076	MPTC: An economical alternative to universal power flow controllers; N. Mohan; EPE 1997, Trondheim, pp 3.1027-3.1030
	33	OD 078	Lexikon der Technik; Luger; Band 2, Grundlagen der Elektrotechnik und Kerntechnik, 1960, pp 395
	34	OD 079	Das Handbuch der Lokomotiven (hungarian locomotive V40 1'D'); B. Hollingsworth et al; Pawlak Verlagsgesellschaft; 1933, pp. 254-255
	35	OD 080	Synchronous machines with single or double 3-phase star-connected winding fed by 12-pulse load commutated inverter. Simulation of operational behaviour; C. Ivarson et al; ICEM 1994, International Conference on electrical machines, Vol. 1, pp 267-272
	36	OD 081	Elkrafthandboken, Elmaskiner; A. Rejminger; Elkrafthandboken, Elmaskiner 1996, 15-20
	37	OD 082	Power Electronics - in Theory and Practice; K. Thorborg; ISBN 0-86238-341-2, 1993, pp 1-13
	38	OD 083	Regulating transformers in power systems- new concepts and applications; E. Wirth et al; ABB Review 04/1997, p 12- 20,
	39	OD 084	Transforming transformers; S. Mehta et al; IEEE Spectrum, July 1997, pp. 43-49
	40	OD 085	A study of equipment sizes and constraints for a unified power flow controller; J. Bian et al; IEEE Transactions on Power Delivery, Vol.12, No.3, July 1997, pp.1385-1391
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	42	OD 087	Hochspannungstechnik; A. Küchler; Hochspannungstechnik, VDI Verlag 1996, pp.365-366, ISBN 3-18-401530-0 or 3-540-62070-2
	43	OD 088	High Voltage Engineering; N.S. Naidu; High Voltage Engineering ,second edition 1995 ISBN 0-07-462286-2, Chapter 5, pp91-98,
	44	OD 089	Performance Characteristics of a Wide Range Induction Type Frequency Converter; G.A. Ghoneem; Ieema Journal, September 1995, pp 21-34
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	47	OD 092	Application of high temperature superconductivity to electric motor design; J.S. Edmonds et al; IEEE Transactions on Energy Conversion 06/1992, No. 2 , pp 322-329
	48	OD 093	Power Electronics and Variable Frequency Drives; B. Bimal; IEEE industrial Electronics - Technology and Applications, 1996, pp.356,
	49	OD 094	Properties of High Polymer Cement Mortar; M. Tamai et al; Science & Technology in Japan, No 63 ; 1977, pp 6-14
	50	OD 095	Weatherability of Polymer-Modified Mortars after Ten-Year Outdoor Exposure in Koriyama and Sapporo; Y. Ohama et al; Science & Technology in Japan No. 63; 1977, pp 26-31
	51	OD 096	SMC Powders Open New Magnetic Applications; M. Persson (Editor); SMC Update ,Vol. 1, No. 1, April 1997
	52	OD 097	Characteristics of a laser triggered spark gap using air, Ar, CH4,H2, He, N2, SF6 and Xe; W.D. Kimura et al; Journal of Applied Physics, Vol. 63, No 6, 15 March 1988, p. 1882-1888
	53	OD 098	Low-intensity laser-triggering of rail-gaps with magnesium-aerosol switching-gases; W. FREY; 11th International Pulse Power Conference, 1997, Baltimore, USA Digest of Technical Papers, p. 322-327

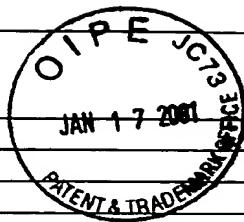
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*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

INFORMATION DISCLOSURE CITATION LIST
ALTERNATE FORM PTO-1449
(Corrected Listing of Original List)

JAN 17 2001



Subtotal	53		
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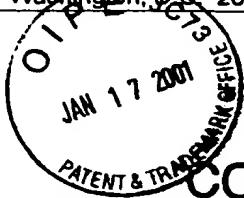
GRAND TOTAL	169		
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Examiner _____ **Date** _____

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*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



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DEC 01 1999

**SPECIAL PROGRAMS OFFICE
DAB FOR PATENTS**

In re Application of
Mats Leijon, et al
Application No. 09/147,325
Filed: February 17, 1999
Attorney Docket No. 9847-0001-
6X

: RESPONSE TO PETITION UNDER
: 37 CFR 1.182 SEEKING SPECIAL
: TREATMENT RELATING TO AN
: ELECTRONIC SEARCH TOOL, AND
: DECISION ON PETITION UNDER
: 37 CFR 1.183 SEEKING WAIVER
: OF REQUIREMENTS UNDER 37 CFR
: 1.98

This is a response to a September 29, 1999 Petition Under 37 CFR 1.182, requesting relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98 in view of the need to file multiple applications relating to different aspects of a particular invention. The petition will be treated as two separate petitions: a first petition under 37 CFR 1.182, relating to submission of an electronic search tool and the need to protect proprietary information therein, and a second petition under 37 CFR 1.183, requesting relief from the § 1.98 provision which requires filing paper copies of references being cited in each of many related applications.

A Decision on the petition under 37 CFR 1.182 re the electronic search tool will be issued in due course.

The petition under 37 CFR 1.183 re the submission of 3 paper copies of IDS citations in a holding application is Granted to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Electronic Search Tool
- Part III. Petition Under 37 CFR 1.183 - Paper Copies

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OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant national stage application filed under 35 U.S.C. 371 currently contains claims 77-153 with three independent claims. The instant application is one of about 200 U.S. applications (either filed or to be filed) with each U.S. application having as many as 40 corresponding foreign applications (either filed or to be filed), the applications relating to different aspects of the invention. An Information Disclosure Citation List has been submitted that lists 259 U.S. patents, 369 foreign patent documents, and 43 other references for a total of 671 citations. Additionally, a list of related cases has been supplied containing 31 U.S. applications and 52 PCT applications. Paper copies have not been supplied in the related applications of any of the citations or the identified related cases.

37 CFR 1.56(b)(1) requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98. 37 CFR 1.56(a).

Petitioner asks "[w]hether the information cited in the manner proposed in [petition] Section 3.1.1 ... is a disclosure that is sufficient to meet the requirements of 37 CFR § 1.56." To the extent that this question refers to the content of the disclosure and the particulars of the subject applications, the Office will not answer the question. It is Office practice not to attempt to define how an individual "ensures" compliance with the rule in a particular application. See, e.g., MPEP 2004. Because determinations on this issue require an evaluation of the intent of the party involved, the Office declines to investigate the question. See MPEP 2010. To the extent that Petitioner's question concerns the form in which the disclosure is provided, rule 56 permits a disclosure in a combination of paper and electronic formats.

Petitioner, in addition to meeting the duty set forth in 37 CFR 1.56 to disclose material information, also wishes to disclose to the Office information that may not meet the definition of

materiality as set forth in the rule¹. Information identified by U.S. or foreign examiners in any of the related U.S. and foreign applications would be cited in each of the related U.S. applications.² In addition, Petitioner seeks to submit other information in each of the related U.S. applications, such as all the co-pending U.S. applications that relate to the invention (useful for determining possible double patenting rejections), and foreign search reports. Petition, page 4.

Rather than be required to submit, via a paper copy, each piece of information in each application each time the information is obtained, Petitioner seeks to have:

- (1) (a) one application (the instant application) identified as a "holding" application which would contain a complete set of paper copies of references; the paper copies to be submitted in only the "holding" application;
- (b) the other related pending U.S. applications, hereafter referred to as the bulk filing applications, will not contain the paper set of reference copies but will contain other information, e.g., a copy of the decision on petition³ permitting such procedure and a copy of the Form 1449 (or equivalent);⁴ and
- (2) an "electronic search tool"⁵ containing different types of information.

The information supplied via the paper copies would be updated monthly, rather than as received from U.S. and foreign examiners, and cancellation of this arrangement would be an option for both

¹Reference to MPEP 2001.05, Petition, page 3.

²Petition, page 3. The present petition requesting relief does not set forth any commitment nor intent by applicant to screen such information for relevancy to each of the U.S. applications in which the information is being cited.

³The original of which would be in the instant holding application.

⁴See, Petition under 37 CFR 1.182, *infra*.

⁵See, Petition under 37 CFR 1.183, *infra*.

Petitioner and the Office upon notice. These, and other more specific conditions, are discussed in further detail in regard to the § 1.182 petition, below.

Petitioner has essentially requested relief in two areas: (1) treatment of information in an electronic search tool, to be submitted independent of any particular application, as in compliance with IDS submission requirements for all bulk filing applications, and (2) the ability to provide the paper copies of each reference in an IDS submission in only one of the bulk filing applications (the instant holding application) as well as two additional sets of copies rather than as is normally required in each application for which the reference (IDS citation) is to be considered. These two areas of relief are independent of each other and drawn toward different regulations. Accordingly, the petition has been treated as two petitions, and the present decision addresses the two areas of requested relief separately. While it is undeniable that relief in both areas would be of benefit to Petitioner, the granting of relief in one area does not, in fact, require the granting of relief in the other. Moreover, in view of the need to further consider the requested relief related to the electronic search tool, deciding the requested relief issues separately permits at this time a partial grant of the original petition.⁶

Part II. Petition under 37 CFR 1.182- Electronic Search Tool

The issues involving the electronic search tool are more extensive than those relating to the requirement for paper copies in each bulk filing application and more time is needed to fully consider and address them. Accordingly, the petition under § 1.182 shall not be decided at this time and is not treated in the instant decision on the § 1.183 petition although it will continue to be considered, with a decision rendered in due course.

⁶It is recognized that petitioner believes the issues presented by the petition may not be decided independent of one another as both the paper copy issue and the electronic search tool issue represent the most complete solution to duty of disclosure issues under 37 CFR 1.56, Petition, fn. 5.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

The submitted petition fee of \$130 will be treated as the § 1.183 petition fee.

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, page 600-102, right-hand column, and page 600-103, left-hand column.

Paper copies: Petitioner notes that the instant application is one of 200 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each reference, brought to the attention of the Office in regard to any one individual application, not be required to be submitted in each such application. Rather, it is requested that three complete sets of paper copies be permitted to be filed: one set for the instant application which will be designated as a holding application; one set to be used to establish new subclasses for the technology; and one set to be used as a reference set should either or both of the other two sets become corrupted (Petition, pages 6 and 7).⁷

Once past the initial IDS submission, it is proposed that applicant would update the IDS submissions once a month, rather than every time a new reference is found, although the time frames required by § 1.97 would have to be complied with, which may mean that submissions may occur more frequently than once a month.

Form 1449: In addition to submission of the three sets of paper copies in the instant "holding" application, the petition proposes that each of the bulk filing applications would receive a Form 1449 listing the reference citations (Petition, page 7) and the Form 1449 (in each of the bulk filing applications) would be updated, pursuant to the time requirements of § 1.97, each time the three sets of paper copies are updated. The petition is

⁷It would presumably up to the Technology Center to determine how best to store the reference set and how it is to be accessed.

silent as to whether other types of information that may be submitted in the holding application IDS, e.g., concise explanations of foreign language documents under § 1.98(a)(3), would also be supplied in all the bulk filing applications.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies), the petition states that upon allowance of the instant holding application the right is reserved to file a petition to suspend action in the instant application so that the application can remain as the holding application (Petition, page 7). Alternatively, upon agreement of the Assignee and a Director of the Technology Center involved, an alternate application may be designated as the holding application.

New subclasses: The petition envisions an affirmative duty on the Technology Center to establish new subclasses that will include each of the references submitted during the course of prosecution of the bulk filing applications.⁸ In addition, the Office is to agree that "[e]xaminers will be required to search these newly created subclasses" (from submissions by the Assignee and later by others) "as part of the routine patent prosecution process." Petition, page 8.

Termination: Petitioner seeks a right of termination,⁹ which is to be a mutual option. Termination is to be by written notice, to the attorney of record if the Office terminates and the filing of a termination request and by contacting the Director of TC 2800 if applicant terminates. Conventional IDS procedures would begin three months after notice of termination.

⁸The new subclasses will later be supplemented by references supplied by others who may file applications related to the same technology.

⁹Although termination is discussed under a section related to licensing of the electronic search tool and the petition generally (Petition, pages 10 and 11), it is presumed that Petitioner intends to have the termination provision apply to the waiver of paper copies if that alone is granted.

37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of references in 200 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications,¹⁰ on balance, there is seen to be sufficient benefit to justify waiver in this instance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.¹¹

¹⁰Even though the technology of the applications may be related, the specific claims of the applications may require different classifications of the applications and the quantity of applications would dictate the need for more than one examiner to timely examine the applications.

¹¹The waiver being granted in this instance is not intended to set a general precedent where there is more than one application containing related subject matter. The Office, however, intends to use the instant grant to study whether the opportunity for waiver can be extended to other applicants in similar circumstances, and whether a more general program can be announced. One factor that will be considered is the extent to which relevant information (that may not be necessarily required by § 1.56(b) but which would nonetheless be useful to the examiner, e.g., § 1.56(a)(1) and (2)), is submitted rather than huge dumps of nonrelevant or marginally relevant information.

It is noted that while the petition only refers to the submission of citations that are made by both U.S. and foreign examiners, the term "include" is used (Petition, page 2) which is open ended. The Petition states that it is the intention to submit a copy of every reference identified both by U.S. examiners in the 200 U.S. applications and by foreign examiners in as many as 40 corresponding foreign applications for each U.S. application (Petition, page 3). It has not been stated whether the current 671 reference citations currently of record represent only those citations made by U.S. and foreign examiners or whether they include citations from other sources, such as a

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing application provided that the following 8 conditions are complied with:

- 1) Three paper copies of each IDS citation are or have been submitted to the Office;
- 2) The (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;
- 3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

- 4) A copy of this Decision is filed in the bulk filing application;
- 5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.
- 6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would

preeexamination search or third party citations. See also Petition, page 19.

have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

- 7) The grant of the § 1.183 petition re § 1.98(a)(2) does not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications,¹² or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.
- 8) The Office has established a series of Official Digests in Class 174 based on the technology represented by the instant invention (a classification schedule thereof is attached). As is the case with all Digests, their usefulness will be continually evaluated. The Office will place the holding application's references in the Digests as they are determined to require such placement and as new ones are brought to the attention of the Office either by Petitioner or a third party. A search of the Digests themselves or what they contain (such as the holding application or reference copy sets), either in paper copy or electronic form, will be

¹²The patent file can be kept in the Technology Center for easy reference, or rather than rely upon the patent, either the reference set of paper copies could be utilized, or the Office may decide to rely on the Digests being created.

conducted when mandatory based on the classification of the claims, or when deemed advisable - on a case by case basis.

Part IV. Summary

A Decision on the Petition under 37 CFR 1.182, drawn toward submission of the electronic search tool, will be acted upon in due course when all outstanding issues are resolved.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted, however, the following is not agreed to:

- the grant of a future petition under 37 CFR 1.103 for suspension from publication of the holding application should it be allowed,
- the required search of subclasses from one of the three sets of paper copies and placement of one of the other sets of paper copies therein, and
- any termination provision more than two months (rather than the three months that the petition sets forth) from notice of termination.

Part V. Further Correspondence

Further correspondence with respect to this matter should be addressed to Hiram H. Bernstein, Senior Legal Advisor, Special Program Law Office, as follows:

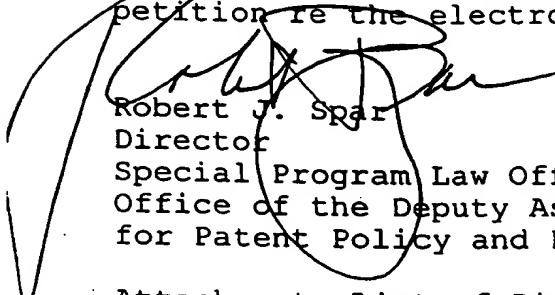
By mail: Commissioner of Patents and Trademarks
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Special Program Law Office

By hand: Special Program Law Office
 Crystal Plaza Four, Suite 3C23
 2201 South Clark Place
 Arlington, VA 22202

Telephone inquiries specific to this matter should be directed to Mr. Bernstein at (703) 305-9285.

The instant application will be retained by this Office: for a period of TWO MONTHS to await any response to the instant Decision, and for the purpose of continuing review of the S 1.182 petition re the electronic search tool.


Robert J. Spar
Director
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Attachment: List of Digests 13-33

Digest 13 **HIGH VOLTAGE CABLE (E.G., ABOVE 10KV, CORONA PREVENTION, ETC.)**

Digest 14 . Having a particular cable application (e.g., winding, etc.)

Digest 15 .. In a power generation system (e.g., prime-mover dynamo, generator system, etc.)

Digest 16 .. In a motive power system (e.g., electric motor control system, etc.)

Digest 17 .. In an electric power conversion, regulation, or protection system

Digest 18 .. In a power distribution network

Digest 19 .. In a dynamo-electric machine

Digest 20 ... Stator

Digest 21 ... Rotor

Digest 22 ... Winding, per se

Digest 23 .. In a circuit breaker, relay, or switch

Digest 24 .. In an inductive device (e.g., reactor, electromagnet, etc.)

Digest 25 ... Transformer

Digest 26 . Having a plural-layer insulation system

Digest 27 .. Including a semiconductive layer

Digest 28 ... Plural semiconductive layers

Digest 29 . Having a semiconductive layer

Digest 30 . Having insulation with a particular dimension or geometry

Digest 31 . Having a shield or metallic layer

Digest 32 . Having means for cooling

Digest 33 . Method of cable manufacture, assembly, repair, or splicing